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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,789	09/15/2003	Thomas E. Chefalas	YOR920010714US1	9514
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DUKE W. YEE YEE & ASSOCIATES, P.C. P.O. BOX 802333 DALLAS, TX 75380			EXAMINER VEILLARD, JACQUES	
			ART UNIT 2165	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/662,789

Applicant(s)

CHEFALAS ET AL.

Examiner

Jacques Veillard

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☒ Claim(s) 24-25 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is responsive to the Applicant's communication filed 03/14/2007.
2. Claims 2-5, 7, 8, 11, 14, 16, 17, 19-21, 23 have been amended, claims 12, 13 canceled, and claims 24-25 have been added as new claims.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claim 8 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per claim 8, a "system" is being cited. However, it appears that one of ordinary skill in the art could interpret the system as a functional descriptive material, data structure, per se. It is clear functional descriptive material when recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized.

While the applicant discloses these data structures are contained in a computer-readable medium, he further defines a computer-readable medium may be a "signal bearing media", "radio frequency" and "light wave" (Spec page 20 line 15, and line 20). A signal encoded with functional descriptive material does not fall within any of the categories of patentable subject matter. It is noted in the MPEP that a product is a tangible physical article or object, which a signal is not. Machine and composition of matter also require physical matter. Furthermore, what is claimed is clearly not a series of steps or acts to constitute a process. Thus a signal does not

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fall within one of the four statutory classes of 35 U.S.C § 101. Therefore, claim 8 is non-statutory.

5. Claims 10-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per claim 10, a “system” made up of two means is being cited. However, it appears that one of ordinary skill in the art could interpret the system as software, per se. As defined in the specification, it is clear that each of the means is a software instruction to be executed, thus constitutes functional descriptive material. When recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized.

While the applicant discloses these instructions are contained in a computer-readable medium, he further defines a computer-readable medium may be a “signal bearing media”, “radio frequency” and “light wave” (Spec page 20 line 15, and line 20). A signal encoded with functional descriptive material does not fall within any of the categories of patentable subject matter. It is noted in the MPEP that a product is a tangible physical article or object, which a signal is not. Machine and composition of matter also require physical matter. Furthermore, what is claimed is clearly not a series of steps or acts to constitute a process. Thus a signal does not fall within one of the four statutory classes of 35 U.S.C § 101. Therefore, claim 8 is non-statutory.

The dependent claims 11-16 included in the statement of rejection but not specifically addressed in the body of the rejection have inherited the deficiencies of their parent claim and

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have not resolved the deficiencies. Therefore, they are rejected based on the same rationale as applied to their parent claims above.

6. Claims 17-23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per claim 17, the Specification page 20, lines 13-22 contains language that makes claim 17 non statutory. "The term "recordable-type medium" specifically the "medium" as used herein, refers to any medium, signal or carrier that provides information or is usable by a processor(s). This passage of the disclosure presents intrinsic evidence showing that Applicant intends for the "medium" to cover something beyond physical articles or objects, which are functionally or structurally interconnected with the instructions in such a manner as to enable the instructions to act as a computer component and realize their functionality. Since such a medium, signal or carrier that the term "medium" referred to may take many forms, including, but not limited to, non-volatile, volatile, and transmission-type media... Transmission-type media includes coaxial cables, copper wires and fiber optics, including the wires that comprise the bus. It is noted that transmission-type media can also take the form of carrier waves, i.e., electromagnetic waves that can be modulated, as in frequency, amplitude, or phase, to transmit information signals. Additionally, transmission media can take the form of acoustic or light waves, such as those generated during radio wave and infrared data communications. Furthermore, the computer-readable media, as described in applicant's disclosure, specification page specifically lines 20-22, may take the form of **coded formats** that are decoded for actual use in a particular data processing system. In this descriptive portion of the spec, the applicant

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appears to be portraying “coded formats” as “computer-readable media”. Presumably, the described “coded formats” are formats of the functional descriptive material. Although, the term “coded formats” is not further explained in the specification, however, the plain meaning of the descriptive phraseology “coded formats” suggests forms of (or plans for) coding of the functional descriptive material. Any form of coding or plan for coding of the functional descriptive material that may be used (or may be available for use) to produce coded functional descriptive material, is merely an abstraction. An abstraction as applied to functional descriptive material does not meet the legal definition of a “manufacture”(or any other statutory class of invention) under 35 USC 101. As such, claim 17 as written and in view of Applicant’s disclosure page 20, lines 13-22, is not limited to a statutory subject matter and is therefore non-statutory.

The dependent claims 18-23 included in the statement of rejection but not specifically addressed in the body of the rejection have inherited the deficiencies of their parent claim and have not resolved the deficiencies. Therefore, they are rejected based on the same rationale as applied to their parent claims above.

### ***Response to Arguments***

7. Applicant's arguments filed March 14, 2007 have been fully considered but they are not persuasive, for the reasons set forth below.

The Examiner has completed a through study of the applicant's arguments. These arguments are not persuasive.

Claims 1-4, 7-11, 16-23 were rejected under 35 USC 103, applicant argued that there is no reasons to combine Howard et al. (U. S. Pat. No. 6,185,574) in view Peltonen et al. (U.S. Pat.

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No.5,926,807) as illustrated in claims 1, 10, and 17 for example. In response to applicant's argument, the examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya, 184 USPQ 607 (CCPA 1975)*. However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin, 170 USPO 209 (CCPA 1971)*. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek, 163 USPQ 545 (CCPA 1969)*. In this case, it would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made modify Howard et al. teachings by Peltonen et al. teachings for the motivation stated on the last Action (paper No.20061206).

Therefore, the examiner asserts that the cited prior arts (mainly Howard) in combination Peltonen et al., U. S. Patent 5,926,807) teach or suggest the subject matter broadly recited in claims 1-4, 7-11, 16-23 as required under 35 U.S.C. 103 (a). (See rejections of claims 1-4, 7-11, 16-23 as set forth in paper No. 20061206).

As per claims 5, 6, 14, 15, 21 and 22, applicant argued that there is no reasons to combine Howard et al.(U. S. Pat. No. 6,185,574) in view Peltonen et al.(U.S. Pat. No.5,926,807). In response to applicant's argument, The Examiner states that the response above applied to the argument regarding claims 5, 6, 14, 15, 21 and 22.

Furthermore, Applicant argued that Howard discloses only the "receiving" and "initiating" of saving file commands without disclosing their "source". In response to

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Applicant's argument that Howard et al. do not include certain features of Applicant's invention, the limitations on which the Applicant relies (i.e., receiving and initiating source) are not in the claims. It is the claims that define the claimed invention, and it is claimed, not specifications that are anticipated or unpatentable. *Constant v. Advanced Micro-Devices Inc*, 7 USPQ2d 1064.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Howard et al. (U. S. Pat. No. 6,185,574) in view of Peltonen et al. U. S. Pat. No. 5,926,807).

As per claims 1, 8, 10, and 17, Howard et al. disclose a system, which including data processing system for locating files in a hierarchical directories as detailed in col.10, lines 10-12, col.12, lines 27-34, col.12, line 66 through col.14, line 6). In particular, Howard et al. disclose the claimed limitations wherein an input has been received indicating that a file is to be saved (See Howard et al. Fig.15 in conjunction with steps 754 and 758, col.31, lines 18-23). Howard et al. specifically disclose that a user can retrieve a file where the file is saved as detailed in col.4, lines 55-57, col.12, lines 16-27). It is noted, however, Howard et al. did not specifically disclose the system for saving the file in association with a unique identifier in a data store, responsive to receiving an input, wherein the data store describes associations between files and unique identifiers and wherein files are retrieved based on unique identifiers. On the other hand,



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Peltonen et al. disclose a system for effectively representing query result in a memory where files have been saved or stored (See Peltonen et al. Title and abstract, col.2, lines 55-67). In particular, Peltonen et al. achieved the claimed limitations of, saving the file in association with a unique identifier in a data store, responsive to receiving an input, wherein the data store describes associations between files and unique identifiers and wherein files are retrieved based on unique identifiers, by providing a bookmark associated with files as a unique identifier to identify files (See Peltonen et al. Abstract lines 14-19, col.9, lines 25-67, col.11, lines 16-39).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention was made to modify the parallel virtual directory system of Howard et al. by incorporating the bookmark mechanism taught by Peltonen et al. because that would have enhanced the system of Howard et al. by allowing it to retrieve files or documents store in data store quickly and efficiently using the bookmark as a unique identifier and return the result appropriately in response to a request (See Peltonen et al. Abstract lines 14-19, col.8, lines 1-6).

As per claim 9, most of the limitations of this claim have been noted in the rejection of claims 1, 10, and 17. Applicant attention is directed to the rejection of claims 1, 10, and 17 above. In addition, the combination of Howard et al. and Peltonen et al, as modified, discloses the claimed limitations further comprising: a bus system; a communication unit connected to the bus system; a memory connected to the bus system (See Howard et al. Fig.1 in which Howard et al. disclose that various components related to virtual directory system, Fig.2 wherein Howard et al. disclose a processing unit including a memory system and a network filesystem connected to a network storage that facilitated communication between them). Therefore, the claim is rejected in the same grounds for arguments given for the corresponding claims 1, 8, and 17 above.

As per claims 2, 11, and 18, most of the limitations of these claims have been noted in the rejection of claims 1, 10, and 17. Applicant attention is directed to the rejection of claims 1, 10, and 17 above. In addition, the combination of Howard et al. and Peltonen et al, as modified, discloses the claimed limitations further comprising: responsive to a request from a requester for files associated with the unique identifier, querying the data store for an identification of the files associated with the unique identifier, receiving a result from the data store; and returning the result to the requester (See Peltonen et al. Abstract lines 14-19).

As per claims 3, 12, and 19, most of the limitations of these claims have been noted in the rejection of claims 1, 10, and 17. Applicant attention is directed to the rejection of claims 1, 10, and 17 above. In addition, the combination of Howard et al. and Peltonen et al, as modified, discloses the claimed limitations, wherein the result is presented as a list of categories to a user. (See Howard et al. col.7, lines 43-53, col.17, lines 25-30).

As per claims 4, 13, and 20, most of the limitations of these claims have been noted in the rejection of claims 1, 10, and 17. Applicant attention is directed to the rejection of claims 1, 10, and 17 above. In addition, the combination of Howard et al. and Peltonen et al, as modified, discloses the claimed limitations, wherein the locations of the file are in a remote data processing system (See Howard et al. Abstract lines 4-5, col.2, lines 45-46).

As per claims 5, 14, and 21, most of the limitations of these claims have been noted in the rejection of claims 1, 10, and 17. Applicant attention is directed to the rejection of claims 1, 10, and 17 above. In addition, the combination of Howard et al. and Peltonen et al, as modified,

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discloses the claimed limitations, wherein input is a user input to save the file (See Howard et al. col.31, lines 18-23).

As per claims 6, 15, and 22, most of the limitations of these claims have been noted in the rejection of claims 1, 10, and 17. Applicant attention is directed to the rejection of claims 1, 10, and 17 above. In addition, the combination of Howard et al. and Peltonen et al, as modified, discloses the claimed limitations, wherein the input is from a program initiating saving of the file (See Howard et al. col.3, lines 64-66, col.31, lines 21-22).

As per claims 7, 16, and 23, most of the limitations of these claims have been noted in the rejection of claims 1, 10, and 17. Applicant attention is directed to the rejection of claims 1, 10, and 17 above. In addition, the combination of Howard et al. and Peltonen et al, as modified, discloses the claimed limitations, wherein the identifier is selected from one of a user name, an event, or a task (See Howard et al. col.4, lines 50-54, col.15, lines 18-23).

#### ***Allowable Subject Matter***

10. Claim 24 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 25 as depending on claim 24 is also objected and will obtain therefore the benefit of claim 24 as parent claim.

#### ***Conclusion***

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacques Veillard whose telephone number is (571) 272-4086.

The examiner can normally be reached on Mon. to Fri. from 9 AM to 4:30 PM, alt. Fri. off..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on (571) 272- 4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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May 15, 2007